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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,067	02/13/2004	Naoki Tsuchiya	Q79844	5628

23373 7590 06/14/2005  
SUGHRUE MION, PLLC  
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WASHINGTON, DC 20037

EXAMINER

STOCKTON, LAURA

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/777,067	Applicant(s) TSUCHIYA ET AL.	
	Examiner Laura L. Stockton, Ph.D.	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.                                                |

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## DETAILED ACTION

Claims 1-16 are pending in the application.

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Due to the numerous variables in the claims, e.g. A, M, B, E, G, J, etc., and their widely divergent meanings, a precise listing of inventive groups cannot be made. The following groups are exemplary:

**Group I.** Claims 1, 2 and 6-16, drawn to products of formula (1) wherein  $R^1$  and  $R^2$  do not together form a ring, X is  $-\text{CH}=\text{}$ , M is a single bond, J is an indole ring and E is  $-\text{COOR}^3$ , classified in class 548, subclass 305.1.

**Group II.** Claims 1, 2, 6-10 and 12-16, drawn to products of formula (1) wherein  $R^1$  and  $R^2$  do not together form a ring, X is nitrogen, M is a single

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bond, J is a benzothiophene ring and E is  $-\text{COOR}^3$ ,  
classified in class 546, subclass 113+.

**Group III.** Claims 1, 2, 6-8 and 10-16, drawn to  
products of formula (1) wherein  $\text{R}^1$  and  $\text{R}^2$  do form a  
ring, X is  $-\text{CH}=$ , M is a single bond, J is an indole  
ring and E is  $-\text{COOR}^3$ , classified in class 548, subclass  
302.1.

**Group IV.** Claims 1-5 and 7-16 (in-part), drawn to  
products of formula (1) wherein  $\text{R}^1$  and  $\text{R}^2$  do not  
together form a ring, X is  $-\text{CH}=$ , M is  $-\text{S}(\text{O})_m-$ , J is an  
indole ring and E is a tetrazole-5-yl, classified in  
class 548, subclass 250+.

Again, this list is not exhausted as it would be  
impossible under the time constraints due to the sheer  
volume of subject matter instantly claimed. Therefore,  
applicant may choose to elect a single invention by  
identifying another specific embodiment not listed in  
the exemplary groups of the invention.

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The inventions are distinct, each from the other because of the following reasons: the products of Groups I-IV differ materially in structure and element so much so as to be patentably distinct. In addition, a reference which anticipates one group may not even render obvious the other.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the search required for Group I, for example, is not required for Group II, restriction for examination purposes as indicated is proper. Therefore, it would impose an undue burden on the Examiner and the Patent Office's resources to examine the instant application if unrestricted.

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The above groups themselves are inclusive of patentably distinct subject matter. Accordingly, along with the election of one of the above groups, the following action is also taken.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (e.g., Example number, page number and structural depiction) from whichever group is ultimately elected, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or

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admission may be used in a rejection under 35

U.S.C. 103(a) of the other invention.

Upon the election of a single disclosed species (e.g. Example, page number and structural depiction), a scope of the elected invention that has been examined, inclusive of the elected species, will be identified by the Examiner for examination.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if

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one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

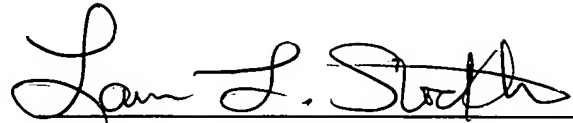
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

A handwritten signature in black ink, appearing to read "Laura L. Stockton", written over a horizontal line.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

June 7, 2005